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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,302	08/11/2000	John Hood	TSRI 710.2	8590

7590

11/03/2003

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EXAMINER

SLOBODYANSKY, ELIZABETH

ART UNIT PAPER NUMBER

1652

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/637,302

Applicant(s)

HOOD ET AL.

Examiner

Elizabeth Slobodyansky

Art Unit

1652

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-3, 5, 6, 14-16 and 41.

Claim(s) withdrawn from consideration: 7-13, 17-40 and 42-67.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

*E. Slobodyansky*  
Elizabeth Slobodyansky  
Primary Examiner  
Art Unit: 1652

Continuation of 2. NOTE: the scope of the claims has been changed to include the limitation "of at least about 0.1 weight percent" that would require further consideration and additional search of the prior art.

Continuation of 5. does NOT place the application in condition for allowance because: for the reasons of record in view of non-entry of the amendment. Applicants argue that neither Freed et al. nor Chow et al. "teach or suggest the use of such compositions to stimulate angiogenesis, as set forth in the label limitation of the claim" (Remarks, page 6). It appears that Applicants equal the instant claims with the method claims for treating the condition associated with deficient angiogenesis. However, the current claims are drawn to a product that comprises an active ingredient, Raf, and a label. Raf is known in the prior art. Applicants argue that "In claim 1, the printed matter on the label should be given patentable weight because the instructions and information on the label impart functionality to the composition. Furthermore, the information on the label vis-à-vis the ability of active Raf proteins to stimulate angiogenesis, is novel, and informs the user of the article how the article is to be utilized. This label limitation is analogous to the situation in Miller where the item at issue was a measuring cup" (page 7). This is not agreed with because in In re Miller, the label was printed on the cup, i.e. the cup itself was changed resulting in a new product while Raf is the same in the prior art and the claims. Applicants further discuss In re Gulack and assert that it "involved a band imprinted with a series of digits derived from a mathematical algorithm. The band could be a hatband, for example, having utility on its own. The printed matter on the band conveyed a new utility to the band, i.e., it was now useful for performing "magic tricks" and for displaying various aspects of number theory" (page 7). This is not persuasive because the claimed band had a new utility only after the band of the prior art was changed, i.e. the product itself is different from the prior art product. The prior art band, i.e. the band without the imprinted digits is not usable for the same purposes as the claimed band. In Gulack, the printed matter not conveys but imparts a new utility to the band. Contrary to that, in the instant case, Raf is the same prior art protein and the label does not impart any new property or utility to Raf but only conveys the intended use. However, the claims are not drawn to a method of use that may be novel, but to the product.